

REMARKS

Claims 1, 3-10, and 12-23 are currently pending in the application. By this amendment, claims 1, 7, 8, and 19 are amended and claims 21-23 are added for the Examiner's consideration. Moreover, claims 2 and 11 are canceled without prejudice or disclaimer. The above amendments and new claims do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments and new claims is provided in the claims as originally filed and at Figures 1 and 2. Particularly, Figure 1 of the instant application shows the bevel is flat or planar, and also shows the bevel is conterminous with both the recess and the convex underside of the tongue. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Advisory Action

Applicants appreciate the Examiner's helpful remarks provided in the Advisory Action dated July 25, 2007.

Information Disclosure Statement

Applicants appreciate the Examiner's consideration of the Information Disclosure Statement filed on October 11, 2006. Submitted herewith is a Supplemental IDS citing the documents that were not considered (i.e., lined through) by the Examiner.

Drawing Objection

Applicants appreciate the indication in the Advisory Action that the reply submitted on July 12, 2007 overcomes the drawing objections. Applicants hereby incorporate by reference

those arguments regarding the drawing objection set forth at pages 8-9 of the reply submitted on July 12, 2007.

Accordingly, Applicants respectfully request that the objection to the drawings be withdrawn.

35 U.S.C. §112 Second Paragraph Rejection

Claim 18 is rejected under 35 U.S.C. §112, 2nd paragraph. The Examiner asserts that the recitation "markings provided on a top side of the board and corresponding to spacing between beams" makes it unclear whether the invention is directed to a floor board or to the floor board and beams to which markings would correspond. This rejection is respectfully traversed.

According to MPEP §2173.02, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Claim 18 recites the building board of claim 8, further comprising markings provided on a top side of the board and corresponding to spacing between beams. Applicants submit that this subject matter is sufficiently described in the specification such that a person skilled in the art would understand what the claimed invention is when the claims are read in light of the specification and the teachings of the prior art. More specifically, in a non-limiting exemplary

embodiment shown in FIG. 4 and described in paragraph [0023], the board 1 is shown with such markings 21.

In the Advisory Action dated July 25, 2007, the Examiner contends that it is unclear whether the claim is directed to only the building board or to the building board and beams. Applicants respectfully submit that claim 18 clearly recites a building board comprising markings. Claim 18 does not recite the combination of a building board and beams. That the building board comprises markings which correspond to spacing between beams is a functional recitation that must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used (see MPEP §2173.05(g)).

Thus, Applicants submit one ordinarily skilled in the art reviewing the original disclosure and pending claims would understand the instant invention and readily ascertain the scope of the invention. Therefore, Applicants submit the instant rejection of claim 18 is improper.

Accordingly, Applicants respectfully request that the rejection over claim 18 be withdrawn.

35 U.S.C. §102 Rejection

Claims 8 and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0079820 issued to Palsson et al. ("Palsson"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP

§2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

Independent Claim 8

As previously discussed, the present invention relates to a building board made of OSB (oriented strand board) which can be laid on beams in order to form a subfloor. Non-limiting exemplary implementations of the invention provide an OSB building board for forming subfloors such that the boards can be reliably oriented parallel to one another and connected to one another. Independent claim 8, as currently amended to incorporate the subject matter of now canceled claim 11, requires that a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel. More specifically, claim 8 recites *inter alia*

... a first longitudinal edge having a tongue;
 a second longitudinal edge opposite the first longitudinal
 edge and having a groove bounded by a top lip and a bottom lip;
 ...
 wherein a front edge of the tongue of the first longitudinal
 edge comprises a bevel and a recess formed in the tongue adjacent
 to the bevel,
 the bottom lip of the second longitudinal edge has a
 concave recess over its length, and
 the tongue of the first longitudinal edge has a convex
 underside which corresponds to the concave recess.

Palsson does not contain this combination of features. Instead, Palsson shows a tongue 11 with a convex underside; however, the front edge of the tongue does not include a bevel and a recess adjacent the bevel (FIGS. 1 and 2). The Examiner impliedly agrees that Palsson does not show this combination of features, since the Examiner did not previously reject claim 11 under §102 in view of Palsson.

Claim 16 depends from allowable claim 8, and is allowable at least for the reasons discussed above with respect to claim 8.

Accordingly, Applicant respectfully request that the §102 rejection of claims 8 and 16 be withdrawn.

35 U.S.C. §103 Rejections

Claim 1 is rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson.

Claims 1, 2, and 11 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of U.S. Patent No. 6,682,254 issued to Olofsson.

Claims 3, 6, and 19 were rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Olofsson as applied to claim 1, and further in view of U.S. Patent Application Publication No. 2002/0056245 issued to Thiers

Claims 4 and 5 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Olofsson as applied to claim 1, and further in view of U.S. Patent Application Publication No. 2003/0035921 issued to Kornicer

Claim 7 is rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Olofsson as applied to claim 2, and further in view of U.S. Patent No. 347,425 issued to Hall.

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Thiers.

Claims 12-14 and 20 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Hall.

Claims 15 and 17 are rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of Kornicer.

Claim 18 is rejected under 35 U.S.C. §103(a) for being unpatentable over Palsson in view of U.S. Patent No. 6,012,255 issued to Smid.

These rejections are respectfully traversed for the following reasons.

Claim 1 in view of Palsson

Independent claim 1, as currently amended to incorporate the subject matter of now canceled claim 2, requires that a tongue of the longitudinal edge have a convex underside, a bevel, and a recess adjacent the bevel. More specifically, claim 1 recites *inter alia*

... wherein the tongue on the longitudinal edge comprises a bevel and a recess adjacent the bevel, and ...

wherein the groove on the longitudinal edge is bounded by a top lip and a bottom lip, the bottom lip projects laterally beyond the top lip and has a concave recess over the entire length, and the tongue has a convex underside which corresponds to the recess.

Palsson does not disclose or fairly suggest this combination of features. Instead, Palsson shows a tongue 11 with a convex underside; however, the tongue does not include a bevel and a recess adjacent the bevel (FIGS. 1 and 2). The Examiner impliedly agrees that Palsson does not show this combination of features, since the Examiner did not previously reject claim 2 under §103 in view of Palsson alone.

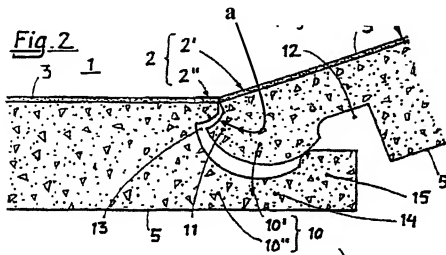
Accordingly, Applicant respectfully request that the §103 rejection of claim 1 be withdrawn.

Claims 1, 2, and 11 in view of Palsson and Olofsson

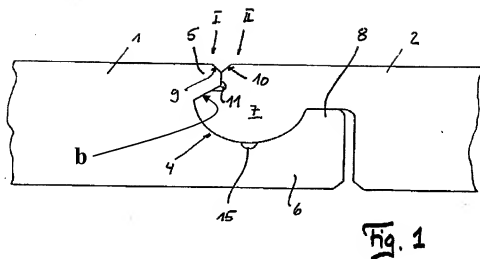
Independent claim 1 recites, in pertinent part, that a tongue of the longitudinal edge has a convex underside, a bevel, and a recess adjacent the bevel. Applicants submit that no proper combination of Palsson and Olofsson discloses or suggests this combination of features.

The Examiner asserts that Palsson discloses a tongue 11 having a convex underside and a bevel. The Examiner acknowledges that Palsson does not disclose a recess adjacent the bevel. Applicants agree that Palsson does not disclose a recess adjacent the bevel. However, the Examiner is of the opinion that Olofsson discloses a tongue having a recess adjacent a bevel, and that it would have been obvious to modify Palsson in view of Olofsson. Applicants respectfully disagree.

Contrary to the Examiner's assertions, Palsson does not disclose a tongue having a convex underside and a bevel. Palsson shows a first edge 2¹ having a tongue 11 that includes a convex underside, as shown in FIG. 2 reproduced below.



The element "a" (as annotated above) does not constitute a bevel, as described and recited in the claimed invention, because it exhibits a wavy (i.e., not flat or planar) contour. The term "bevel" is defined by <http://dictionary.reference.com/browse/bevel> as "the inclination that one line or surface makes with another when not at right angles," or "a surface that does not form a right angle with adjacent surfaces." Moreover, FIG. 1 of the instant invention, reproduced below, shows the bevel "b" as a flat (i.e., planar) surface.



Therefore, Palsson does not disclose a tongue having a convex underside and a bevel.

In any event, Olofsson does not disclose a recess adjacent to a bevel. In the Final Office Action, the Examiner asserts that Olofsson shows in FIGS. 5 and 6 a bevel (the not numbered angled flat surface at the distal end of the tongue 2) and a recess 6. Applicants acknowledge that Olofsson shows a bevel and a recess. However, the bevel is not adjacent the recess, as required by claim 1. As clearly seen in FIG. 5, the recess is located at a proximate end of the tongue 2 where the tongue 2 connects to the core, and the bevel is located at the distal end of the tongue. That is, the recess 6 and bevel are located at opposite ends of the tongue, with other features (i.e., wedges 3) disposed between the recess 6 and bevel. As such, the recess 6 is clearly not adjacent the bevel, as recited in claim 1.

Applicants thank the Examiner for the further explanation of the Examiner's interpretation of the terms "bevel" and "adjacent" in the Advisory Action dated July 25, 2007. Nevertheless, Applicants submit that Olofsson does not disclose or suggest a tongue comprising a bevel and a recess adjacent the bevel, and that Olofsson's disclosure would not lead one to modify Palsson to include a bevel and a recess adjacent the bevel, as recited in the claimed invention. The Examiner first explains that the recess in Olofsson may include the entire region

above the tongue. Applicants respectfully disagree, and note that the claimed invention recites that the tongue comprises the recess (claim 1) and the recess is formed in the tongue (claim 8); therefore, the recess must be formed in the tongue. Olofsson's region above the tongue does not constitute a recess formed in the tongue, and, therefore, cannot reasonably be considered as a tongue comprising a recess.

The Examiner alternatively notes that Olofsson shows a bevel (i.e., a surface of guiding wedge 3) adjacent the recess 6 (FIG. 5). Without acquiescing in this interpretation, Applicants note that modifying Palsson by adding such a guiding wedge 3 would render Palsson unsatisfactory for Palsson's intended tilting and pivoting installation method (see, e.g., paragraphs [0010] and [0038]). That is, adding such an additional structural feature to Palsson would interfere with the snug fit between Palsson's tongue and correspondingly shaped groove, thereby making it impossible to insert the tongue in a tilted manner and subsequently pivot the panels into locking engagement (see, e.g., paragraph [0010] where Palsson describes a "snap" fit). According to MPEP §2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, the proposed modification of adding Olofsson's guiding wedge 3 and recess 6 to Palsson is improper based upon MPEP §2143.01.

In a third alternative interpretation of Palsson and Olofsson, the Examiner notes that Palsson discloses a bevel, that Olofsson teaches a recess 6, and that would be obvious to modify Palsson to place a recess adjacent the bevel. Applicants respectfully disagree, and note that Olofsson does not disclose or suggest a recess adjacent a bevel as recited and described in the claimed invention. Instead, Olofsson clearly shows other features between the recess 6 and the

bevel (at the distal end of the tongue). Since none of the references show the combination of features as recited in the claimed invention, Applicants submit the only reasonable rationale for modifying Palsson in the manner asserted by the Examiner is found in Applicants' own disclosure, which is an impermissible use of hindsight that cannot support a rejection under 35 U.S.C. § 103(a). Put another way, the Examiner is suggesting to assemble features of the prior art in a way that is not gleaned from the facts of the prior art, but rather is only described in Applicants disclosure. Therefore, no proper combination of Palsson and Olofsson discloses or suggests a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Regarding claims 2 and 11, these claims are canceled by the instant amendment, thereby rendering the rejection of these claims moot. Accordingly, Applicant respectfully request that the §103 rejection of claims 1, 2, and 11 be withdrawn.

Claims 3, 6, and 19 in view of Palsson, Olofsson, and Thiers

Claims 3, 6, and 19 depend from allowable claim 1, and are allowable for the reasons discussed above with respect to claim 1. Moreover, Thiers does not compensate for the deficiencies of Palsson and Olofsson with respect to claim 1. That is, Thiers, like Palsson and Olofsson, does not disclose a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Accordingly, Applicant respectfully request that the §103 rejection of claims 3, 6, and 19 be withdrawn.

Claims 4 and 5 in view of Palsson, Olofsson, and Kornicer

Claims 4 and 5 depend from allowable claim 1, and are allowable for the reasons discussed above with respect to claim 1. Moreover, Kornicer does not compensate for the deficiencies of Palsson and Olofsson with respect to claim 1. That is, Kornicer, like Palsson and

Olofsson, does not disclose a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Accordingly, Applicant respectfully request that the §103 rejection of claims 4 and 5 be withdrawn.

Claim 7 in view of Palsson, Olofsson, and Hall

Claim 7 depends from allowable claim 1, and is allowable for the reasons discussed above with respect to claim 1. Moreover, Hall does not compensate for the deficiencies of Palsson and Olofsson with respect to claim 1. That is, Hall, like Palsson and Olofsson, does not disclose a tongue having a convex underside, a bevel, and a recess adjacent the bevel.

Accordingly, Applicant respectfully request that the §103 rejection of claim 7 be withdrawn.

Claims 9 and 10 in view of Palsson and Thiers

Claims 9 and 10 depend from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Thiers does not compensate for the deficiencies of Palsson with respect to claim 8. That is, Thiers, like Palsson, does not disclose a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel

Accordingly, Applicant respectfully request that the §103 rejection of claims 9 and 10 be withdrawn.

Claims 12-14 and 20 in view of Palsson and Hall

Claim 20

Independent claim 20 recites, in pertinent part:

... wherein the groove on the longitudinal edge is bounded
by a top lip and a bottom lip, the bottom lip projects laterally

beyond the top lip and has a concave recess over the entire length, the tongue has a convex underside which corresponds to the recess, and the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

The Examiner acknowledges that Palsson does not disclose a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head. The Examiner asserts that Hall discloses a bottom lip B having a plurality of spaced apart recesses c configured to accommodate countersunk nail or screw heads, and that it would have been obvious to modify Palsson in view of the teachings of Hall. Applicants respectfully disagree.

Palsson shows, in FIGS. 1 and 2, a groove 13 formed by a bottom lip 14. The bottom lip 14 has a concave recess over its length. However, the bottom lip 14 does not comprise a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

Hall does not compensate for the deficiencies of Palsson with respect to claim 20 because Hall does not disclose a plurality of spaced apart depressions in a bottom lip that bounds a groove. Hall shows a tile for lining (i.e., facing) walls. The tile comprises a body portion A and a lip or flange portion B. Applicants acknowledge that the flange B comprises holes c for screws or nails (FIGS. 1 and 2). However, Hall's flange B does not constitute a bottom lip as recited in the claimed invention. That is, claim 20 recites a groove corresponding to a tongue, wherein the groove is bounded by a top lip and a bottom lip, wherein the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head. Hall's flange B is not a bottom lip that bounds a groove that corresponds to a tongue. Instead, Hall's element B is merely a flange that extends from body A. Therefore, neither Palsson nor Hall shows a groove corresponding to a tongue, wherein the groove is bounded by a top lip and a

bottom lip, wherein the bottom lip has a plurality of spaced apart depressions configured to accommodate a countersunk nail head or screw head.

In the Advisory Action, the Examiner contends that Hall discloses a bottom lip “B” with a plurality of spaced apart depressions, since a lip and a flange are not mutually exclusive. The Examiner further explains that modifying Palsson to include a plurality of spaced apart depressions “c” as taught by Hall would place the spaced apart depressions in the bottom lip of Palsson that bounds a groove. Applicants submit, however, that Hall’s flange does not constitute a bottom lip having a groove of a tongue-and-groove connection. Moreover, Hall does not disclose or suggest the plurality of recesses in the groove. Therefore, Hall does not reasonably suggest adding a plurality of recesses to the groove of the bottom lip of Palsson.

Accordingly, Applicant respectfully request that the §103 rejection of claim 20 be withdrawn.

Claims 12-14

Claims 12-14 depend from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Palsson and Hall do not show the features additionally recited in claim 12. That is, no proper combination of Palsson and Hall teaches or suggests a plurality of spaced apart recesses provided along the bottom lip of the second longitudinal edge.

As discussed above with respect to claim 20, Hall does not show a plurality of spaced apart recesses provided along the bottom lip of a tongue and groove connection. Hall’s flange B does not constitute a lip that bounds a groove, as required by claim 8 from which claim 12 depends.

Accordingly, Applicant respectfully request that the §103 rejection of claims 12-14 and 20 be withdrawn.

Claims 15 and 17 in view of Palsson and Kornicer

Claims 15 and 17 depend from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Kornicer does not compensate for the deficiencies of Palsson with respect to claim 8. That is, Kornicer, like Palsson, does not disclose a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel

Accordingly, Applicant respectfully request that the §103 rejection of claims 15 and 17 be withdrawn.

Claim 18 in view of Palsson and Smid

Claim 18 depends from allowable claim 8, and are allowable for the reasons discussed above with respect to claim 8. Moreover, Smid does not compensate for the deficiencies of Palsson with respect to claim 8. That is, Smid, like Palsson, does not disclose a tongue of the first longitudinal edge have a convex underside, a bevel on its front edge, and a recess adjacent the bevel

Accordingly, Applicant respectfully request that the §103 rejection of claim 18 be withdrawn.

New Claims

New claims 21-23 are added by this amendment, and are fully supported by the original disclosure. For example, FIG. 1 of the instant application shows the bevel is flat or planar, and also shows the bevel is conterminous with both the recess and the convex underside of the tongue.

Claim 21 depends from allowable claim 1 and additionally recites the bevel is a flat or planar surface. Claim 23 depends from allowable claim 8 and additionally recites the bevel is a flat or planar surface. Palsson's surface (referred to as "a" above) is not a flat or planar surface. Instead, as can clearly be seen in FIGS. 1 and 2 of Palsson, the surface "a" is either an arc or a wavy, undulating surface. Therefore, the applied art does not disclose or suggest a tongue comprising a bevel, a recess adjacent the bevel, and a convex underside, wherein the bevel is a flat or planar surface.

Claim 22 depends from allowable claim 1 and additionally recites the bevel is conterminous with both the recess and the convex underside of the tongue. According to <http://dictionary.reference.com/browse/conterminous>, the word *conterminous* means *having a common boundary; bordering; contiguous; meeting at the ends; without an intervening gap*. Neither Palsson nor Olofsson shows a tongue comprising a bevel, a recess adjacent the bevel, and a convex underside, wherein the bevel is conterminous with both the recess and the convex underside of the tongue.

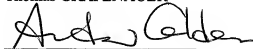
Other Matters

Claims 7 and 19, which previously depended from now canceled claim 2, are amended to depend from claim 1.

CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
Thomas GRAFENAUER

A handwritten signature in black ink, appearing to read "Andrew Calderon", written over a horizontal line.

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